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EXAMINER

ROBINSON BOYCE, AKIBA K

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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SEP 06 2007

GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/905,579
Filing Date: July 12, 2001
Appellant(s): CHOW, CARL S.

MAILED

SEP 06 2007

GROUP 3600

Thomas A. Olson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/29/07 appealing from the Office action
mailed 11/29/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6134568	TONKIN	10-2000
EP 0621563	LONG	10-1994

(9) Grounds of Rejection

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The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, in independent claims 19 and 27, these claims were amended to recite "wherein the client does not specify an arrangement of components to create the document". The applicant points to Fig. 4 of the applicant's drawings as well as the written specification in its entirety for support of this amendment. However, these citations are unconvincing to the examiner. With reference to Fig. 4 of the applicant's drawings, step S212 describes a technical literature selection. However, technical literature is no more than an arrangement of technical components loaded into a literary document. In addition, the written specification describes determining publication characteristics in addition to the technical data. For example, on Page 2, paragraph 2 of the specification, applicant describes that in addition to making a determination as to the content of a given publication, the overall theme, the general layout, the quantity of data contained, the level of detail provided, and the number and type of illustrations and/or photographs contained in the publication is disclosed. All of the specifications thus

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described relates to the arrangement of components to create a document. For example, when incorporating the number and type of illustrations and/or photographs contained in the publication, the components are represented by the illustrations and/or photographs since they are arranged by number and type in order to create the publication. Since the independent claims 19 and 27 were amended to recite "wherein the client does not specify an arrangement of components to create the document", this phrase causes the claims to fail to comply with the enablement requirement, thus this phrase can not be considered by the examiner in rejecting the claim. Since independent claims 19 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, the claims that depend from them are rejected as well (claims 20-26, and 28-34 respectively).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin (US 6,134,568) in view of Long (EP 0621563 A1).

As for Claims 19, Tonkin discloses a method comprising:

providing a client interface, a literature assembly algorithm, and a database containing information, wherein the client interface includes at least a portion of a

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network (see Fig. 1, also abstract, lines 1-6, interface, w/ col. 13, lines 54-56, database, w/Col. 3, lines 62-64, connected to a wide area network (WAN), w/ Abstract, lines 1-27, shows the assembly of a document, w/Col. 17, lines 27-29, algorithm is inherent with a computer-executable process since the computer needs to execute some type of algorithm to carry out it's processes);

detecting a client inquiry via the interface (see Fig. 3, steps [202]-[204], determining if initial request was received, w/ Fig. 5A, shows a screen where user will enter a name for a new document to be retrieved);

presenting the information to the client via the client interface in response to the inquiry; (Fig's 5B-F, shows the presentation of information pertaining to the document during the request of document test); and

receiving a client selection of at least a portion of the information via the client interface in response to presenting the information, (Fig's 5B-F, shows the presentation of user selections during the request, for example user selects Volvo as the source file);

in response to receiving the client selection, assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document, (Col. 13, lines 17-30, user accepts document, and order request is transmitted, then the assembly of the document is facilitated, in this case an arrangement of components is clearly shown in the abstract, lines 1-12, also, since if one is arranging a document, the processing/assembly of the document would involve processing/assembling components of the document since a document has components. Specifically, Col. 13, lines 42-5 shows that the order and appearance of

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the document for an order, along with the formatted information may be arranged in different ways. *Furthermore, the order information is automatically evaluated and routed* in col. 13, lines 52-54. Since automatic evaluation of the order leads to routing to a production location, this serves as a representation of specifying an arrangement of components to create the document);

obtaining an electronic image comprising:

the document, (figure 8A element 632), an image of selected binder, and figure 4, step 24, the user selects a different portion of the document]).

Tonkin does not specifically disclose a postage marking calculated based on a total weight of a booklet; and printing the electronic image onto one or more sheets of print media, but does teach a system which enables a user to preview a document by providing a user interface and inputting, via the user interface, information specifying an arrangement of components to create the document as shown in the abstract, and also discloses the consideration of the distance of the geographical location of a production location to a recipient's location, and estimating based on the zip code when routing an document order, in col. 13, lines 52-63, thereby suggesting mailing.

However, Long teaches, a postage marking calculated based on a total weight of a booklet; and printing the electronic image onto one or more sheets of print media, (col. 5, lines 43-56, indicates weight of a stuffed envelope to the franking machine so that proper postage may be printed on the envelope). Long discloses this limitation in an analogous art for the purpose of showing a system and method for preparing items for

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mailing, which calculates the postage and prints it on the booklet, wherein the postage amount is calculated by the total weight of selected items with known weights.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to calculate the exact postage for the booklet of Tonkin based on the total weight of the booklet and print the electronic image (including the postage) onto one or more sheets of print media at the document production locations (such as locations 71 to 73 in Fig. 1 of Tonkin), as taught by Long, for the purpose of charging proper postage to the corresponding booklet.

As Per Claim 27, Tonkin discloses:

providing a literature assembly algorithm and a client interface, wherein the client interface comprises at least a portion of network, (see Fig. 1, also abstract, lines 1-6, interface, w/ col. 13, lines 54-56, database, w/Col. 3, lines 62-64, connected to a wide area network (WAN), w/ Abstract, lines 1-27, shows the assembly of a document, w/Col. 17, lines 27-29, algorithm is inherent with a computer-executable process since the computer needs to execute some type of algorithm to carry out it's processes);

detecting a client inquiry via the client interface, (see Fig. 3, steps [202]-[204], determining if initial request was received).

presenting an information selection prompt via the interface in response to the client inquiry (Fig's 5B-F, shows the presentation of information pertaining to the document during the request of document test, where the selection prompt is represented by the drop-down box selection prompt);

receiving a client selection via the client interface in response to presenting the information selection prompt (Fig's 5B-F, shows the presentation of user selections during the request, for example user selects Volvo as the source file via drop-down box selection prompt);

accessing a read only memory device and retrieving selected data corresponding to the client selection; (figure 2, [element 154], read only memory);

in response to receiving the client selection, assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document, (Col. 13, lines 17-30, user accepts document, and order request is transmitted, then the assembly of the document is facilitated, in this case an arrangement of components is clearly shown in the abstract, lines 1-12, also, since if one is arranging a document, the processing/assembly of the document would involve processing/assembling components of the document since a document has components. Specifically, Col. 13, lines 42-5 shows that the order and appearance of the document for an order, along with the formatted information may be arranged in different ways. *Furthermore, the order information is automatically evaluated and routed* in col. 13, lines 52-54. Since automatic evaluation of the order leads to routing to a production location, this serves as a representation of specifying an arrangement of components to create the document);

obtaining an electronic image comprising:

the document, (figure 8A element 632), an image of selected binder, and figure 4, step 24, the user selects a different portion of the document]).

Tonkin does not specifically disclose a postage marking calculated based on a total weight of a booklet; and printing the electronic image onto one or more sheets of print media, but does teach a system which enables a user to preview a document by providing a user interface and inputting, via the user interface, information specifying an arrangement of components to create the document as shown in the abstract.

However, Long teaches, a postage marking calculated based on a total weight of a booklet; and printing the electronic image onto one or more sheets of print media, (col. 5, lines 43-56, indicates weight of a stuffed envelope to the franking machine so that proper postage may be printed on the envelope). Long discloses this limitation in an analogous art for the purpose of showing a system and method for preparing items for mailing, which calculates the postage and prints it on the booklet, wherein the postage amount is calculated by the total weight of selected items with known weights.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to calculate the exact postage for the booklet of Tonkin based on the total weight of the booklet and print the electronic image (including the postage) onto one or more sheets of print media at the document production locations (such as locations 71 to 73 in Fig. 1 of Tonkin), as taught by Long, for the purpose of charging proper postage to the corresponding booklet.

As for Claims 20 and 28, Tonkin further discloses:

presenting a name and address prompt via the client interface; and receiving a client name and postal address, (Fig. 9 presents name and address, which occurs after the user specifies information in the document creation window).

As for Claims 21 and 29, Tonkin further discloses:

wherein the electronic image includes the client name and postal address (Fig. 9 presents name and address, which occurs after the user specifies information in the document creation window, also see the computer system of EP reference includes the electronic image of the mail piece including the name and postal address).

As for Claims 22 and 30, Tonkin further discloses:

wherein the further selected information comprises an image to be purchased by the client, (figure 4 step 24, the user selects a different portion of the document], w/ Fig. 8A shows image in Tonkin).

As for Claims 23 and 31, Tonkin does not specifically disclose that the image is form of sheet music, but Tonkin does disclose various type of images, in the form of graphics, pictures, or various type of text.

It would have therefore been obvious to one having ordinary skill in the art to include the sheet music as one type of image for the purpose of printing text in the form of sheet music when requested by the client.

As for Claims 24 and 32, Tonkin further discloses:

wherein the image is artistic graphics, (see Fig. 8A).

As for Claims 25 and 33, Tonkin further discloses:

wherein the image is literary text (see Fig. 8A).

As for Claims 26 and 34, Tonkin further discloses:

wherein the image is technical data (see Fig. 8A).

(10) Response to Argument

As per claim 19, appellant first argues that Tonkin does not disclose *providing...a literature assembly algorithm, and...assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document*. Appellant points to the specification to the specific passage: organize the requested literature together in a logical sequence and order, and argues that when viewed in the light of the specification, the claim term includes the above stated passage. However, it is noted that the organization of the requested literature together in a logical sequence and order feature upon which appellant relies is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, in Col. 13, lines 17-30, Tonkin discloses that a user accepts document, and order request is transmitted, then the assembly of the document is facilitated, in this case an arrangement of components is clearly shown in the abstract, lines 1-12. Furthermore, since if one is arranging a document, the processing/assembly of the document would involve processing/assembling components of the document since a document has components. Specifically, Col. 13, lines 42-5 shows that the order and appearance of the document for an order, along with the formatted information may be arranged in different ways. *Furthermore, the order information is automatically evaluated and routed* in col. 13, lines 52-54. Since automatic evaluation of the order leads to routing to a production location, this serves as a representation of specifying an arrangement of components to create the document.

Second, appellant argues that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. However, KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396. Claims 19-34 recited combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under *KSR*.

Third, appellant argues that examiner has employed impermissible hindsight reconstruction. However, in response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In addition, appellant argues that the term "booklet" does not appear anywhere in either Tonkin or Long. However, Tonkin uses the term, "document". Tonkin does not only disclose a document, but discloses assembling a document. Since a booklet is no more than an assembly of documents or sheets, Tonkin at least suggest a booklet without actually saying "booklet". However, Tonkin specifically discloses the steps of putting a booklet together in the Abstract lines 16-22. These lines include a tab page, front cover, back cover, and binding, which suggests a booklet.

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In addition, appellant argues that has not found anything similar to the phrase or concept of "print the electronic image including postage" in either of the cited prior art references. However, it is the combination of Tonkin and Long that disclose this feature. First, Tonkin discloses the consideration of the distance of the geographical location of a production location to a recipient's location, and estimating based on the zip code when routing an document order, in col. 13, lines 52-63, thereby suggesting mailing. Long specifically indicates weight of a stuffed envelope to the franking machine so that proper postage may be printed on the envelope in col. 5, lines 43-56, for the purpose of showing a system and method for preparing items for mailing, which calculates the postage and prints it on the booklet, wherein the postage amount is calculated by the total weight of selected items with known weights.

As per claim 27, appellant makes similar, yet close to identical arguments to those of claim 19. Claim 27 is therefore rejected for the same reasons.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

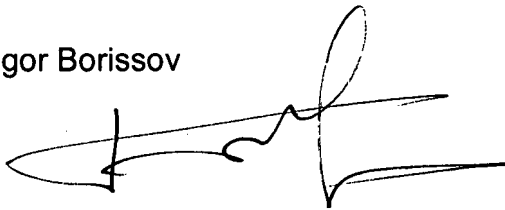
Respectfully submitted,

Akiba Robinson-Boyce

A handwritten signature in black ink, appearing to read 'Akiba Robinson-Boyce', written in a cursive style.

Conferees:

Igor Borissov

A handwritten signature in black ink, appearing to read 'Igor Borissov', written in a cursive style.

Vincent Millin

A handwritten signature in black ink, appearing to read 'Vincent Millin', written in a cursive style.